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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/883,499 | 06/19/2001 | Jeffrey A. Bedell | 53470.003034 | 8688 |

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| EXAMINER |
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RIMELL, SAMUEL G

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| ART UNIT | PAPER NUMBER |
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2164

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07/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/883,499

Applicant(s)

BEDELL ET AL.

Examiner

Sam Rimell

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12,14-21 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19,20,26 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12,14-18, 21, 27,29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 2164

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: Claim 1 calls for the evaluation of a plurality of methods for generating intermediate data sets. This is followed by a query language statement assembled and run against the data source. The claim is unclear since it is not clear what result, if any, is produced by the evaluating step and how such result is related to the remainder of the claimed invention.

Claims 2-3 and 5-9: Depend on claim 1.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10- 12, 14-18, 21, 27 and 29 are rejected under 35 U.S.C. 101 because the claimed invention is non-statutory.

Claim 10: The last step of claim 10 is a step of evaluating a plurality of methods, from which no result is produced. Claim 10 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology "computer implemented method" does not render the claimed invention statutory since the result of the invention is the not computer itself.

Claims 11-12 and 14-18: Depend on claim 10.

Claim 21: The last step of claim 21 is a step of evaluating a plurality of methods, from which no result is produced. Claim 21 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology “computer implemented system” does not render the claimed invention statutory since the result of the invention is the not computer itself.

Claim 27: The last steps of claim 27 involve steps of evaluating a plurality of methods, from which no result is produced. Claim 27 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology “computer implemented method” does not render the claimed invention statutory since the result of the invention is the not computer itself.

Claim 29: The last steps of claim 29 involve steps of evaluating a plurality of methods, from which no result is produced. Claim 29 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology “computer implemented system” does not render the claimed invention statutory since the result of the invention is the not computer itself.

No prior art is applied. Claims 1-3 and 5-9 would be allowed if amended to overcome the rejections under 35 USC 112, second paragraph. Claims 10-12, 14-18, 21, 27, 29 would be allowed if amended to overcome the rejections under 35 USC 101.

Claims 19-20, 26 and 28 are allowed.

Art Unit: 2164

Applicant is reminded that amendments to claims which result a broadening of scope of the claims may necessitate new prior art rejections.

This office action is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell
Primary Examiner
Art Unit 2164